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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

FIS920030398US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" (37 CFR 1.8(a))

Application Number

10/708,066

Filed

2/6/2004

On _____

First Named Inventor

Signature _____

Roger Lam et al.

Typed or printed name

Art Unit

2835

Examiner

B. Chervinsky

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.



Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/90)

Sean F. Sullivan

Typed or printed name

attorney or agent of record.

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

November 3, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	Total of <u>1</u> forms are submitted.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: ROGER LAM, ET AL.)
Serial No.: 10/708,066) Group Art Unit: 2835
Filed: February 6, 2004)
For: METHOD AND STRUCTURE FOR) Examiner: Chervinsky, B.
HEAT SINK ATTACHMENT IN)
SEMICONDUCTOR DEVICE) Confirmation No.: 2065
PACKAGING)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed August 3, 2005, and in conjunction with the Notice of Appeal filed concurrently herewith, the Applicants submit the following remarks in support of the Pre-Appeal Brief Request for Review:

REMARKS

The present submission is responsive to the Final Office Action of August 3, 2005, in which claims 1-20 are presently pending. Of those, claims 1, 4, 6, 8, 11, 14, 17 and 19 have been rejected under 35 U.S.C. §102(b), as being anticipated by U.S. Patent 6,218,730 to Toy, et al. In addition, claims 3, 5, 7, 10, 12, 13, 16, 18 and 20 have been rejected under 35 U.S.C. §103(a), as being unpatentable over Toy, et al. The remaining claims 2, 9 and 15 have been rejected under 35 U.S.C. §103(a), as being unpatentable over Toy, et al., in view of U.S. Patent 6,730,993 to Boyer, et al.

The Examiner has failed to establish a *prima facie* case in support of the existing §102 and §103 rejections for the reason that Toy does not teach or suggest "at least one spacer member in contact between said substrate surface and said heat sink..." as claimed in the instant application. (See more specifically Applicants' amendment of July 7, 2005, page 5)

In response, the Examiner states in the Final Office Action (on paragraph 6, pages 3-4) that "the elements 20, 51 and 50 in combination can be considered as the heat sink because their primary function is to dissipate heat generated by the IC chip 16." (Emphasis added) However, it is respectfully submitted by the Applicants that there is no support for such an interpretation in the Toy reference and, as such, the basis for the Examiner's rejections is erroneous.

This is not an instance where the Toy reference teaches a claimed element, but simply uses a different term to describe that element. Rather, Toy explicitly discloses a "heat sink" which is clearly depicted as element 50 in Figure 1 of the Toy reference. Moreover, it is seen that the Toy heat sink 50 is not actually in contact with the "spacer member" 47 identified by the Examiner. Instead, the Examiner has erroneously

attempted to expand the definition of "heat sink" to cover the combination of the lid 20, the conductive adhesive 51, and the heat sink 50.

Nowhere in the Toy reference is it indicated that the heat sink comprises elements 20, 50 and 51 together. Nor does the reference indicate the primary function of the lid 20 is to dissipate heat generated by the IC chip 16. Although lid 20 and adhesive 51 can act as a thermally conductive medium through which heat generated by the chip can be ultimately carried to the heat sink 50, neither the lid 20 nor the adhesive 51 acts as the *heat sink* itself. Because the claims of the instant application recite that the spacer member is in contact between the substrate surface and the heat sink, a determination that Toy meets this element is in clear error because the lid 20 is not a heat sink.

For the above stated reasons, it is respectfully submitted that the final rejection of claims 1-20 is in error and that the same are allowable over the art of record. The fee set forth in 37 CFR 41.20(b)(1) is enclosed herewith. However, if any fees are due with respect to this submission, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,
ROGER LAM, ET AL.

CANTOR COLBURN LLP
Applicants' Attorneys

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